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JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

October Term, 1967
No. 1228

TOOL RESEARCH AND ENGINEERING CORPORATION,
Petitioner,

vs.

HONCOR CORPORATION,
Respondent.

Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

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TOOL RESEARCH AND ENGINEERING CORPORATION,
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vs.

HONCOR CORPORATION,
Respondent.

Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Petitioner, Tool Research and Engineering Corporation, prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Ninth Circuit, entered in the above-entitled case on September 29, 1966.

Opinions Below.

The District Court opinion is reported in 240 F. Supp. 296, 145 USPQ 249, and the judgment, Findings of Fact and Conclusions of Law therein are attached hereto and collectively referred to as Appendix A. The Court of Appeals decision, attached as Appendix B, is reported in 367 F. 2d 449, 151 USPQ 236.

Jurisdiction.

The Court of Appeals entered judgment on September 29, 1966 and denied a petition for rehearing on November 8, 1966. On January 27, 1967 the Honorable William O. Douglas ordered that the time for filing the Petition for Writ of Certiorari be extended to April 6, 1967. This Court has jurisdiction under 28 U.S.C. Sec. 1254(1).

Questions Presented.

1. Whether the Ninth Circuit Court of Appeals has decided a federal question in a way in conflict with an applicable decision of this court, namely, *Smith & Griggs Mfg. Co. v. Sprague,* 123 U.S. 249 (1887).

2. Whether or not 35 U.S.C. Sec. 103, enacted in 1952 overruled the decision in *Smith & Griggs Mfg. Co. v. Sprague,* 123 U.S. 249 (1887), as interpreted by the Ninth Circuit Court of Appeals.

3. Whether the Ninth Circuit Court of Appeals has decided an important question of federal law which has not been, but should be, settled by this Court, namely, whether the conditions of patentability in 35 U.S.C. Sec. 103 may be applied not as of the date the invention was made, but more than one year prior to the patent application, to invalidate the invention under 35 U.S.C. Sec. 102(b).

4. Whether the Ninth Circuit Court of Appeals has rendered a decision in conflict with the decisions of the Sixth Circuit Court of Appeals on the same matter,

namely, the legal test to be applied in determining whether a prior use invalidates a patent under 35 U.S.C. Section 102(b).

Statutes Involved.

35 U.S.C. Section 102(b) provides that:

> "(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, . . ."

35 U.S.C. Section 103 provides that:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Statement of the Case.

Petitioner sued defendant Honcor for infringement of Green, *et al.* U.S. Letters Patent No. 2,975,263, which was filed July 6, 1954 and issued March 14, 1961. The claims thereof covered the preformed method of making honeycomb core used as a reinforcing material in aircraft and missiles. Green, *et al.* invented

the preformed method "in 1952 or the fore part of 1953." 240 F. Supp. 296, 145 USPQ 249, at p. 251.

The Circuit Court of Appeals concluded the following:

1. In June, 1957, Petitioner abandoned all claims in the application relating to the flat-pack method of making honeycomb core, and elected to rely solely on the preformed method. Appendix B, p. 18.

2. There is no doubt that there are differences in the two methods of producing honeycomb core. Appendix B, p. 19.

> "That there are differences in the two methods of producing honeycomb core is irrefragable. The one method uses flat foil, employs relatively flat fingers, requires pressure from the welding wheel to bend an upper foil to meet a lower one, and requires a mechanical step of expansion. The other method uses pre-corrugated foil, square fingers, requires no pressure to bring the area to be welded together, and eliminates the expansion step. The pre-formed method lends itself more readily to automation and produces a more uniform core."

3. There was a public use of the product produced by the flat pack method more than one year prior to the filing date on the preformed method (July 5, 1954). See Appendix B, p. 20 as follows:

> "The record fairly shows that during the period of 1952, 1953 and 1954 the use of welded stainless steel honeycomb core was relatively new. Ma-

> jor aircraft producers were testing it and experimenting with machines to produce it. During this period standards were being developed for the core. Plaintiff using the flat-pack method prior to June, 1953 produced and filled at least four separate orders for core. The money value of the core definitely shown to have been sold was not great, somewhere between five and six hundred dollars. Some core produced by the flat-pack method was given away. It is probable that most, if not all, of the core sold and given away was used by the purchasers for test and experimental purposes, but certainly plaintiff put no limitation on the use to be made of it. The sales of core were sufficient to put the flat-pack method into public use and we cannot say on the record that the District Court erred in not finding the use experimental."

This conclusion was based on the findings in the District Court that: (a) the method (flat pack) of making core had not been changed and (b) there were no secrecy limitations on the above noted sales. 240 F. Supp. 296, 145 USPQ 249, 252.

4. There were no sales of the product produced by the preformed method more than one year prior to July 6, 1954. Appendix B, p. 20.

5. The claims directed to the preformed method were invalid under Sec. 102(b) because of a public use of the product produced by the flat-pack method more than one year prior to July 6, 1954.

6. The District Court found that the preformed method was not obvious to one skilled in the art at the time the invention was made under Section 103. See 240 F. Supp. 296, 145 USPQ 249, at 254:

> "The court does not conclude in the case at bar that a skilled artisan, in the making of welded stainless steel honeycomb core, could, having in mind the disclosures of the above numbered patents cited by defendant, obtain the method of making core as set forth in Claims 1 to 4 of Pat. '263 without some inventive advance. It appears to the court that there is a new and novel result and inventive faculty over the prior art sufficient to support Claims 1, 2, 3 and 4 of Pat. '263 and that Method Patent '263 was not invalid by reason of the prior art."

7. The claims covering the preformed method were invalid under Section 102(b) because they were obvious to a person skilled in the art at a time one year prior to July 6, 1954, and in concluding this, both courts relied on *Smith & Griggs v. Sprague,* 123 U.S. 249 (1887).

REASONS FOR GRANTING THE WRIT.

I.

The Ninth Circuit Court of Appeals Decided a Federal Question in a Way in Conflict With an Applicable Decision of This Court.

After stating that none of the previously considered rules "quite compel a result here", the Court of Appeals considered *Smith & Griggs v. Sprague,* 123 U.S. 249 (1887), and erroneously concluded:

> ". . . that the sale of a product made by a machine not identical with the one patented constituted a public use . . .". Appendix B, p. 22.

Although in *Smith & Griggs,* the Supreme Court held Claims 1, 2, 3, 4, and 6 of Sprague Letters Patent No. 228,136 and Claims 2, 3 and 5 of Sprague Letters Patent No. 231,199 invalid because of a public use more than two years prior to the application date of December 2, 1878 of a machine which was identical with said claims (at pp. 253-254), the District Court herein overlooked the fact that the Supreme Court, in *Smith & Griggs,* held Claim 5 of No. 228,136 and Claims 1 and 4 of No. 231,199 valid and infringed.

The Court in *Smith & Griggs* went even one step further and concluded that had the inventor sought to patent, as a unit, a combination of the machine that had been in public use and the improvements made within the two-year period, such claim would have been allowed. The Court reasoned, "for, in that view, it would have been imperfect and incomplete, and merely experimen-

tal, until it had received from its inventor every element necessary to its operation." 123 U.S. 249, 256. As this court will note from the record, this is precisely what course Petitioner took, only to have it overturned by a misreading of *Smith & Griggs*.

The allowed claims in *Smith & Griggs* covered improvements that were made within the two-year period. In the words of the Court, the patentee added two improvements in 1878, ". . . the springs between the levers and the dies, . . . and the rib m^3, . . ." (at p. 255), "which improvements . . . (were) contained in the three additional claims, and which were added as parts of the invention within two years before the date of application" (at p. 254). So, the claims that were not identical with the machine in public use were held valid and infringed, even though the differences were "apparently not of great importance" (at p. 255).

Thus, *Smith & Griggs* does not hold that the sale of a product made by a machine not identical with the one patented constitutes a public use.

Furthermore, as indicated above there is other strong language in *Smith & Griggs* that directly supports Petitioner's argument that the claims covering the preformed method were not invalidated by the public use of the non-identical flat pack method.

The Circuit Court held in *Smith & Griggs* that it was not true that an inventor could not safely use, for profit, for more than two years before the invention was completed and the patent applied for, a machine which "demanded and received the continuous experiments of the inventor to remedy defects in its organization". The Supreme Court commented:

> "We think this view might be correct and applicable to the case if the invention of the complainant, which he sought to embody and protect by the patents, consisted of the entire machine as he ultimately constructed and operated it, considered as a unit; for, in that view, it would have been imperfect and incomplete, and merely experimental, until it had received from its inventor every element necessary to its operation."

In short, the Supreme Court said that Sprague could also have obtained a valid claim had he combined the machine in public use *and* the improvements made within the two year period.

Consequently, *Smith & Griggs* is authority that the claims covering the preformed method are valid because:

(1) they incorporate improvements not in public use more than one year prior to the filing of the Green, *et al.* application;

(2) they are not "identical" with the flat pack method allegedly in public use; as the Court of Appeals said, there was no public use of "the exact method patented". Appendix B, p. 22;

(3) the preformed claims consist of the entire process "as . . . [the inventors] ultimately constructed and operated it, considered as a unit"; and

(4) they were developed from the flat pack method which "demanded and received the continuous experiments of the inventor[s] to remedy defects in its organization".

II.

35 U.S.C. Section 103, Enacted in 1952, Overruled Smith & Griggs as Interpreted by the Ninth Circuit Court of Appeals.

If *Smith & Griggs* were to hold, as the Court of Appeals said it did, that "the sale of a product made by a machine not identical with the one patented constitutes a public use", this holding would directly conflict with 35 U.S.C. Section 103, enacted in 1952, which provides that an invention must be "identically disclosed" in the prior use described in Section 102(b). See *Chicopee v. Columbus Fiber Mills,* 165 F. Supp. 307, 118 USPQ 53, 65 (M.D. Ga. 1958); *Adams v. Columbus Mfg. Co.,* 180 F. Supp. 921, 124 USPQ 92, 95 (M.D. Ga. 1960); *Felburn v. New York Central,* 350 F. 2d 416, 146 USPQ 622, 626 (6th Cir. 1965); *Wolowitz v. Gulf Oil,* 255 F. Supp. 100, 149 USPQ 737, 739 (D.C. 1966); *Technicon v. Cole,* 255 F. Supp. 630, 150 USPQ 227, 233 (N.D. Ill. 1966); *Kaiser v. McLouth,* 257 F. Supp. 372, 150 USPQ 239, 250, 253, 256, 266 (E.D. Mich. 1966); *George R. Churchill v. American Buff;* 365 F. 2d 129, 150 USPQ 417, 418 (7th Cir. 1966); *J. L. Clark Mfg. Co. v. American Can,* ..... F. Supp. ....., 151 USPQ 313, 321 (D. N.J. 1966); *Ling-Tempco-Vought v. Kollsman,* ..... F. 2d ....., 152 USPQ 446, 449 (2d Cir. 1967).

III.

The Ninth Circuit Court of Appeals Has Decided an Important Question of Federal Law Which Has Not Been, but Should Be, Settled by This Court, Namely, Whether the Conditions of Patentability in 35 U.S.C. Section 103 May Be Applied Not as of the Date the Invention Was Made, but More than One Year Prior to the Patent Application, to Invalidate the Invention Under 35 U.S.C. Section 102(b).

The Court of Appeals held the Green, *et al.* patent invalid under Section 102(b), saying, Appendix B, p. 23:

> ". . . the invention should fall within 102(b) if the differences between the claimed thing and the sold or used thing are obvious to one skilled in the art."

And, although no evidence whatsoever was introduced on the question of "obviousness," the District Court concluded:

A. The preformed method was obvious in light of the flat-pack method; and

B. The experimental sale of the flat-pack method product was a public use of the preformed method.

Thus, the Court of Appeals superimposed the obviousness test of Section 103 on Section 102(b) by finding obviousness at a time "more than one year prior to the date of the application for patent", instead of applying the obviousness test of Section 103 "at the time the invention was made", which in this case was "in 1952 or the fore part of 1953". 240 F. Supp. 296, 145 USPQ 249, 251. In other words, the Ninth Circuit Court of Appeals ignored the words "identically

disclosed" in Section 103 and effectively revised that Section to read as follows (deletions in brackets and additions italicized):

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious [at the time the invention was made] *at any time more than one year prior to the date of the application for patent in the United States* to a person having ordinary skill in the art to which said subject matter pertains."

This decision will have far-reaching, harmful effects on the purposes of the patent system and on small defense contractors.

One of the purposes of the patent system is to encourage dissemination of information concerning discoveries and inventions. *Brenner v. Manson,* 383 U.S. 519, 148 USPQ 689, 695 (1966). Yet, petitioner's only sin was to sell experimentally (which the court found to be public use) too early the product of a process different from the invention patented. Petitioner made the product available to major aircraft producers "for test and experimental purposes", Appendix B, pp. 20, 21, in order to determine the value of the product, and which methods to pursue. This had the healthy effect of stimulating competitors to invent other processes for making the product. In making the

product available, Petitioner relied upon the fact that the use was experimental and furthermore the invention of the flat pack method by its assignors was not a part of the prior art at the time its assignors invented the preformed process. Now, Petitioner finds that it should have withheld the product of the flat pack process until at least July 6, 1953, one year prior to the application date. If it had, however, the development of aircraft and missiles would have been retarded and competition to develop a better process for making the product would have been stymied.

The District Court concluded that:

A. The preformed method was obvious in the light of the flat-pack method;

B. The experimental sale of the flat-pack method product was a public use of the flat-pack method; and,

C. Because "preformed" was obvious in light of "flat-pack", the use of flat-pack became a public use of preformed under Section 102(b).

Such holdings of the District Court, without any evidence on the issue of obviousness before it, had the effect of precluding Petitioner from meeting the issue of whether the two processes in question were obvious extensions from each other under the current state of the art. Had Petitioner been given notice that this was an issue in the case, it could have easily met its burden of proof and could have conclusively established that the use of the flat-pack material was purely and solely an experimental use, and would therefore have avoided and

made immaterial the conclusion that the preformed method was obvious from the flat-pack method.

It is not an answer to say that Petitioner could have filed a patent application on the preformed claims earlier. The cost of patents is a substantial cost of doing business, especially since the recent enactment of the new fee bill, Public Law 89-83, effective October 25, 1965, 35 U.S.C. Section 41. Petitioner was entitled to keep the preformed process secret until it could determine that the market for the product would justify the patent costs. This it did only to find that the patent was invalid because of the alleged prior public use of the product of a different, inferior and commercially unsuccessful process. The decision of the Court of Appeals, therefore, encourages either (1) a secrecy impossible for a small inventor to maintain or (2) the immediate and indiscriminate patenting of each commercially unsuccessful process at substantial cost prior to any determination of the value of its product in the market place.

Either alternative imposes substantial burdens on small defense contractors, such as the Petitioner, which exists on subcontracts from prime government contractors. These companies are in no position to make secrecy demands on the prime contractors, nor are they financially able to undertake an expanded patent program. Even if they were, the result would be a needless load on an already overburdened Patent Office. See Report of the President's Commission on the Pat-

ent System, page 2. The result is exemplified in this case: the Petitioner is deprived of its rights to a really significant improvement invention because it permitted a test and experimental use of a product made by a different, inferior and commercially unsuccessful invention. Consequently, to avoid the risk of a commercially successful improvement being declared obvious over a prior, inferior invention, the inventor or assignee must now keep both secret until one year prior to the filing date of the application on the perfected invention or file immediately on the inferior and commercially unsuccessful invention. As pointed out, this retards both scientific development and competition in the development of new ideas, neither of which is consistent with the purposes of the patent system.

In part, the result here is also due to the statement of the Circuit Court of Appeals that:

> "Where a process patent is involved and there is a sale of a product of the process, such is a public use of the process if the product sold discloses the process, or even if it does not." Appendix B, p. 22.

In this case it is uncontradicted that the product used experimentally did not disclose the flat pack method, nor did Petitioner intend to disclose said method. Accordingly, this Court should also review the above principle of law in the light of its contributing adverse effect on the purposes of the patent system.

IV.

The Ninth Circuit Court of Appeals Has Rendered a Decision in Conflict With the Decisions of the Sixth Circuit Court of Appeals on the Same Matter, Namely, the Legal Test to Be Applied in Determining Whether a Prior Use Invalidates a Patent Under 35 U.S.C. Section 102(b).

The Ninth Circuit decision in this case is in conflict with the Sixth Circuit decision in *Felburn v. New York Central,* 350 F. 2d 416, 146 USPQ 622, 626 (6th Cir. 1965). There, the Court of Appeals reversed a District Court finding of lack of novelty under Section 102 because the inventions were not "identically disclosed" more than one year prior to the application date. The Court did not superimpose the obviousness test of Section 103 on Section 102 at that time, although the inventions were obvious to a person skilled in the art at that time, as well as at the time the inventions were made. *Accord: Chicopee v. Columbus Fiber Mills,* 165 F. Supp. 307, 118 USPQ 53, 65 (N.D. Ga. 1958); *Adams v. Columbus Mfg. Co.,* 180 F. Supp. 921, 124 USPQ 92, 95 (M.D. Ga. 1960); *Wolowitz v. Gulf Oil,* 255 F. Supp. 100, 149 USPQ 737, 739 (D.C. 1966); *Technicon v. Cole,* 255 F. Supp. 630, 150 USPQ 227, 233 (N.D. Ill. 1966); *Kaiser v. McLouth,* 257 F. Supp. 372, 150 USPQ 239, 250, 253, 256, 266 (E.D. Mich. 1966); *George R. Churchill v. American Buff,* 365 F. 2d 129, 150 USPQ 417, 418 (7th Cir. 1966); *J. L. Clark Mfg. Co. v. American Can,* .... F. Supp. ...., 151 USPQ 313, 321 (D. N.J. 1966); *Ling-Tempco-Vought v. Kollsman,* .... F. 2d ...., 152 USPQ 446, 449 (2d Cir. 1967).

The decision of the Ninth Circuit in this case is supported by *Dix Seal v. New Haven Trap Rock,* 236 F. Supp. 914, 144 USPQ 57, 61-63 (D. Conn. 1964) and *Bros. v. Browning,* 317 F. 2d 413, 137 USPQ 624, 625 (8th Cir. 1963).

In addition to the conflict in the Courts of Appeal, there is a conflict within the Court of Customs and Patent Appeals. *In re Foster,* 343 F. 2d 980, 145 USPQ 166 (CCPA 1965).

The instant case is yet an additional example of the results that obtain because of the *Foster* opinion which in at least one jurisdiction has modified Section 103 so as to include in its terms a time bar which does not appear in the words of Section 103 itself, and where 102(b) is found interpreted to include a public use of a product which is not identical to the product sought to be patented.

Petitioner, aside from being given no notice that the obviousness question was before the District Court, was likewise given no notice that the issue of obviousness would be read into Section 102(b), nor that 102(b) contained a time bar which prohibited the patent of a process which was not identical to the process experimentally used.

Another basic result that necessarily follows from *Foster,* and which has appeared in this case with dynamic effect, is the ambivalent application of Section 102(b). In one place, the Circuit Court concludes that "there was no change or experimentation in 'said method' in the making of core using flat material after 1952, and the core made and sold was by a method in a perfected state"; Appendix B, p. 20. In another

part of its opinion, the Circuit Court concludes that "the sales of core made by the flat-pack method constituted a public use of the preformed method". Appendix B, p. 24.

In other words, applying a single standard: if Section 102(b) does not include the obviousness condition, the preformed method claims could not have been invalidated because they were not identically disclosed. However, if Section 102(b) does include the obviousness condition, then the preform method claims could not have been invalidated because they required changes and experimentation in order to be perfected.

Conclusion.

It is respectfully submitted that the decision of the Ninth Circuit Court of Appeals conflicts with an applicable decision of the United States Supreme Court (*Smith & Griggs);* that the Ninth Circuit Court of Appeals has decided various federal questions of national importance that should be reviewed by this Court; and that there is a conflict between the circuits on an important question under the Patent Statute.

For these reasons, and for the other reasons stated in this Petition, Petitioner respectfully submits that this Petition for Writ of Certiorari to review the judgment of the Ninth Circuit Court of Appeals should be granted.

Respectfully submitted,

SIDNEY DORFMAN,

Attorney for Petitioner.

APPENDIX A.

Judgment.

United States District Court for the Southern District of California, Central Division.

Tool Research and Engineering Corporation, Plaintiff, vs. Honcor Corporation, Defendant. Civil Action No. 985-61-EAC.

This cause having been heard on May 6-8, 12-15, and June 5, 9-10, 1964, and the issues having been duly tried and a decision having been duly rendered, now in accordance with the findings of fact and conclusions of law, signed concurrently herewith,

IT IS ORDERED AND ADJUDGED that:

I

Green, et al, United States Letters Patent No. 2,975,263 is invalid.

II

Claims 5 and 6 of Anspach, United States Letters Patent No. 2,951,145 are invalid.

III

Defendant has not infringed claims 1-4 of Patent No. 2,975,263, said patent being invalid.

IV

Defendant has not infringed claims 5 and 6 of Patent No. 2,951,145, said patent claims being invalid.

V

Plaintiff's complaint is dismissed.

VI

Defendant shall have judgment against Plaintiff for its taxable costs of this action in the amount of $.....

Dated: ....., 1964.

.....

District Judge

Approved:

Disapproved: as to form this ..... day of ....., 1964.

Thomas P. Mahoney
Attorney for Plaintiff

Receipt of a copy of the Proposed Judgment is acknowledged at 1:10 o'clock P.M. this 21 day of Sept. 1964.

Thomas P. Mahoney
Attorney for Plaintiff

Findings of Fact and Conclusions of Law.

United States District Court for the Southern District of California, Central Division.

Tool Research and Engineering Corporation, Plaintiff, vs. Honcor Corporation, Defendant. Civil Action No. 985-61-EAC.

FINDINGS OF FACT

I

Plaintiff Tool Research and Engineering Corporation is a Delaware corporation having a principal place of business at 9460 Wilshire Boulevard, Beverly Hills, California.

II

Defendant Honcor Corporation is a California corporation having a principal place of business at 12832 Chadron Avenue, Hawthorne, California.

III

This Court has jurisdiction of the parties and of the subject matter of this cause of action under 28 USC 1338(a), 1338(b), and venue herein is proper.

IV

The complaint charges Defendant with wilful and wanton infringement of the Green-Hagan-Barnes Patent No. 2,975,263, also referred to as Green '263, entitled "Method for Producing Honeycomb Structure", filed July 6, 1954, and issued March 14, 1961.

V

The complaint also charges Defendant with wilful and wanton infringement of the Anspach Patent No. 2,951,145, also referred to as Anspach '145, entitled "Method and Apparatus for Fabricating Honeycomb

Core", filed April 28, 1958, and issued August 30, 1960. Claims 1 to 4, inclusive, were withdrawn from contention by Plaintiff during the trial leaving claims 5 and 6 to be considered.

VI

Plaintiff has been and now is the owner of the patents in suit by assignment from John J. Foster Mfg. Co.

VII

Defendant denies infringement, although admitting claims 5 and 6 of Anspach '145 are readable upon Honcor Machine No. 2, and contends that both the Green '263 and Anspach '145 patents are invalid.

VIII

Defendant also contends Green '263 is invalid and unenforceable because procured by fraud.

VALIDITY OF GREEN '263

IX

Green '263 discloses a method of making core using flat material and precorrugated material referred to as "said method" in the patent at column 3, line 28; any difference between the use of the "said method" with flat material and with precorrugated material being such as to be obvious to one skilled in the art.

X

The disclosures of Green '263 directed to the structure and method of the machines of Figures 7 and 8, which Plaintiff admitted did not make core, as well as the disclosure of the structure and method illustrated in Figures 9 to 12, inclusive, are unclaimed and are not involved in this action.

XI

The "said method" using flat material *and known as the "flat pack method"* [E.A.C.] was in public use in 1952 and early 1953, more than one year prior to the filing of Green '263 on July 6, 1954.

XII

The Foster sales of core made by "said method" were without limitation as to secrecy, or otherwise, and without any obligation on the part of the buyer to report to Foster upon what had been done with the core purchased.

XIII

There was no change or experimentation in "said method" in the making of core using flat material after 1952, and the core made and sold was by a method in a perfected state.

XIV

Claims directed to "said method" using precorrugated material were inserted for the first time in the Green '263 patent application on June 28, 1957. *The Green 263 patent application contained disclosures which were adequate basis for the claims directed to the pre-expanded core material method.* [E.A.C.]

XV

Foster began the manufacture and sale of core by "said method" using precorrugated material in 1955.

XVI

The prior patent art of itself did not teach "said method", or of itself teach the method of the Green '263 claims 1 to 4, using precorrugated material, said art included Partiot 2,445,801, Black 2,065,511 and

Young 2,065,546, disclosing welded precorrugated material; and Smith 2,324,435 teaching the use of square fingers in the welding of precorrugated material.

INFRINGEMENT OF GREEN '263

XVII

No findings are made with respect to the question of prima facie infringement of Green '263.

VALIDITY OF ANSPACH '145

XVIII

Anspach '145 discloses a machine for making core using a precorrugated strip and contains six claims, all of which were urged until the end of the trial when all but claims 5 and 6 were withdrawn.

XIX

Claims 5 and 6 of Anspach '145 are limited to a narrow electrode finger which is of lessor width than the cell in which it is located and to which a preformed strip is being welded, but which spans the opposite nodal areas of the cell, the finger being associated with a stripper plate having an opening therein through which the finger is insertable, and with a bed plate.

XX

The function of the welding finger in Anspach '145 is to effect welding at the front node of the cell.

XXI

The extension of the welding finger rearwardly from the node being welded is a matter of design for strength and the finger can be extended towards the nodal area spaced from the node being welded until contact is made, that being the limiting position.

XXII

There was no evidence that any new or surprising result was obtained by extending the finger from the leading node of the cell being welded into contact with the node spaced rearwardly therefrom. Any difference existing between the welding finger of Anspach '145 and the welding fingers of the prior art is merely a matter of degree.

XXIII

The patent to Wegeforth 2,843,722, filed April 2, 1956, discloses a honeycomb core-making machine basically like the Anspach machine of the '145 patent construction.

XXIV

Wegeforth '722 was cited as a reference during the prosecution of Anspach '145 in the Patent Office.

XXV

Wegeforth '722 teaches the equivalent of Anspach's welding finger, stripper plate, and bed plate, all substantially like their respective counterparts in Anspach '145 and cooperating as in Anspach. Any differences between the Anspach '145 and Wegeforth '722 constructions are merely matters of degree.

XXVI

Wegeforth's Machine No. 2, built in accordance with the Wegeforth patent, was in operation in April of 1955 and embodied a stripper plate with an opening for the welding finger, said stripper plate being positioned above the core, the welding finger passing therethrough to welding position, and a bed plate underlying the core and cooperating with the stripper plate to form a core-receiving space, all substantially like and cooperating as

in Anspach '145. Any differences between the Wegeforth Machine No. 2 and Anspach '145 are matters of degree.

XXVII

Wegeforth used various types of movable electrodes including roller electrodes in 1955.

XXVIII

The Wegeforth Machine No. 2 made a belt on April 1, 1955, was in production by April 25, 1955, and produced in continuous production quantities in 1955.

XXIX

The patent to Wilson 3,051,824 was filed January 10, 1958, and issued August 28, 1962.

XXX

Wilson '824 teaches a welding finger, a stripper plate, and a bed plate, all being equivalents of their counterparts in Anspach '145 and all cooperating as in Anspach '145; any differences between the Anspach '145 and Wilson '824 structures are merely matters of degree.

XXXI

Plaintiff did not carry its burden of proof to establish that Anspach made his invention prior to January 10, 1958, the filing date of Wilson '824.

XXXII

The Wilson machine was made in accordance with the Wilson Patent 3,051,824, *except for the difference in the shape of the electrode finger.* [E.A.C.]

XXXIII

The Wilson machine was operable to produce usable core, core which passed the Convair "core tests".

XXXIV

The Wilson machine at Foster was used in the production of core in 1956, some of which was sold prior to the Anspach filing date of April 28, 1958, and prior to any date to which Anspach was entitled.

XXXV

Foster had four additional Wilson machines constructed after making core with Wilson's first machine.

XXXVI

The Hexcel machine No. 2 concerning which Roger Steele, Chairman of the Board of Hexcel Products testified, embodied welding fingers and stripper plates, was in public use and in the production of core sold publicly in February of 1956, more than one year prior to the Anspach filing date of April 28, 1958.

XXXVII

The welding fingers of the Hexcel machine which satisfactorily produced core and were narrow, extended substantially from node to node, not quite spanning the cell, the clearance being one to five thousandths of an inch.

XXXVIII

The claims of the Anspach '145 patent were readable upon the Hexcel machine with the exception of the immaterial fingerspanning-the-cell feature.

XXXIX

The extent to which a welding finger extends rearwardly from the node being welded is a matter of choice, and there was no proof that contact with the rear node was an improvement. The rearward extension was merely a matter of choice.

XL

Welding fingers of various sizes and shapes, including fingers narrower than the cell, were old prior to Anspach in Wilson 3,051,824; Wegeforth 2,843,722; Pigo 2,789,203; Wegeforth machine; and Hexcel machine.

XLI

Welding fingers which span the cell were old prior to Anspach in Wilson 3,051,824; Wasilisin 2,780,716; Spott 2,821,616; Wegeforth machine; Smith 2,324,435, Figures 9 and 10; Partiot 2,445,801, Figure 1.

XLII

Square welding fingers spanning a cell were old prior to any date to which Anspach is entitled as a date of invention in Green-Hagan '263 and in the Wegeforth Machine No. 2.

XLIII

The Board of Interference Examiners in Interference 88,982 held that no invention was required to narrow the Green-Hagan '263 square finger.

XLIV

Hexcel used welding fingers which were narrower than the cell, and substantially cell-spanning, prior to any date to which Anspach was entitled as a date of invention.

XLV

Welding fingers narrower than the cell were old long prior to any date of invention to which Anspach was entitled as evidenced by Wegeforth '722, by the Hexcel Machine No. 2, and by Wilson '824.

XLVI

Stripper plates which hold the core as the welding finger is withdrawn after the welding operation were old prior to any date to which Anspach was entitled as a date of invention as shown by Wegeforth '722, by Wilson '824 and were used in production by Wegeforth, by Hexcel, and by Wilson.

XLVII

The stripper plates of the prior art performed the same functions as the stripper plate of Anspach '145, the Hexcel stripper plate having an opening which closely encloses the welding fingers; the Wegeforth stripper plate having a larger opening, the differences being matters of degree.

INFRINGEMENT OF ANSPACH '145

XLVIII

No findings are made with respect to the matter of prima facie infringement of Anspach '145.

THE ALLEGED FRAUD

XLIX

The oath, which Mr. Hagan admitted reading before signing and which was filed with the Green '263 patent application included the (misrepresentation) *statement* that the disclosed method had not been in public use for more than one year prior to the filing of the application, and the (misrepresentation) *statement* that core in the 'already expanded' condition had been made in accordance "with said method", but the Court does not find that (these misrepresentations) they were fraudulently made.

CONCLUSIONS OF LAW

1. This Court has jurisdiction of the subject matter and of the parties.

2. Plaintiff Tool Research and Engineering Corporation is the owner of all right, title and interest in and to Letters Patent to Green-Hagen 2,975,263 and Anspach 2,951,145.

3. The Green-Hagan '263 patent is invalid because directed to subject matter in public use more than one year prior to the filing date of the application which resulted in the patent.

4. The claims of the Green-Hagan '263 patent call for a method using precorrugated material which is "unpatentable over" the same method using flat material which was in public use more than one year prior to the filing date of the Green '263 patent.

5. The invention claimed in the Green '263 patent is the invention disclosed and the claims thereto are invalid under 25 USC 102(b).

6. The Anspach '145 patent is invalid as being directed to a machine which was unpatentable in view of the earlier patent to Wegeforth 2,843,722.

7. The patent to Anspach '145 is unpatentable in view of the prior invention and public use of the Wegeforth machine more than one year prior to its filing date.

8. The Anspach '145 patent is invalid in view of the prior invention and public use of the Hexcel machine more than one year prior to its filing date.

9. The Anspach '145 patent is invalid as being directed to a machine which was unpatentable in view of the earlier Wilson patent 3,051,824.

10. The Anspach '145 patent is invalid in view of the prior invention and public use of the Wilson machine more than one year prior to its filing date.

11. The test for invention, as set forth in Title 35 USC Section 103, is not met by the Anspach '145 patent in suit, and that patent is invalid.

12. An invalid patent cannot be infringed and Defendant has not infringed Green '263 and Anspach '145.

13. A judgment shall be entered holding claims 5 and 6 of Anspach 2,951,145 and claims 1 to 4, inclusive, of Green 2,975,263 to be invalid and dismissing this action for infringement. Said judgment shall provide that Defendant shall recover its taxable costs in the amount of $..... and have judgment therefor.

Dated: Oct. 13, 1964.

.....

District Judge

Approved:

Disapproved: as to form this ..... day of ....., 1964.

Thomas P. Mahoney
Attorney for Plaintiff

Receipt of a copy of the above Findings of Fact and Conclusions of Law is acknowledged at 1:10 o'clock P.M. this 21 day of Sept.. 1964.

/s/ Thomas P. Mahoney
Thomas P. Mahoney
Attorney for Plaintiff

APPENDIX B.

Opinion of the United States Court of Appeals for the Ninth Circuit.

United States Court of Appeals for the Ninth Circuit.

Tool Research and Engineering Corporation, Appellant, vs. Honcor Corporation, Appellee. No. 20,002.

[September 29, 1966]

Appeal from the United States District Court for the Southern District of California, Central Division.

Before: JERTBERG and ELY, Circuit Judges; and SMITH, District Judge.

SMITH, District Judge:

Plaintiff[1] appeals from a judgment holding invalid J. E. Green et al. Patent No. 2,975,263, a patent on a method of making metallic honeycomb core. The purpose of the core is to maintain the surface sheets of panels used in aircraft and missiles in a spaced relationship with each other. The district court held that the prior art did not teach plaintiff's claimed method but that by reason of the plaintiff's sales of honeycomb core the rights to a patent on the process were lost under Section 102(b), Title 35 U.S.C.[2]

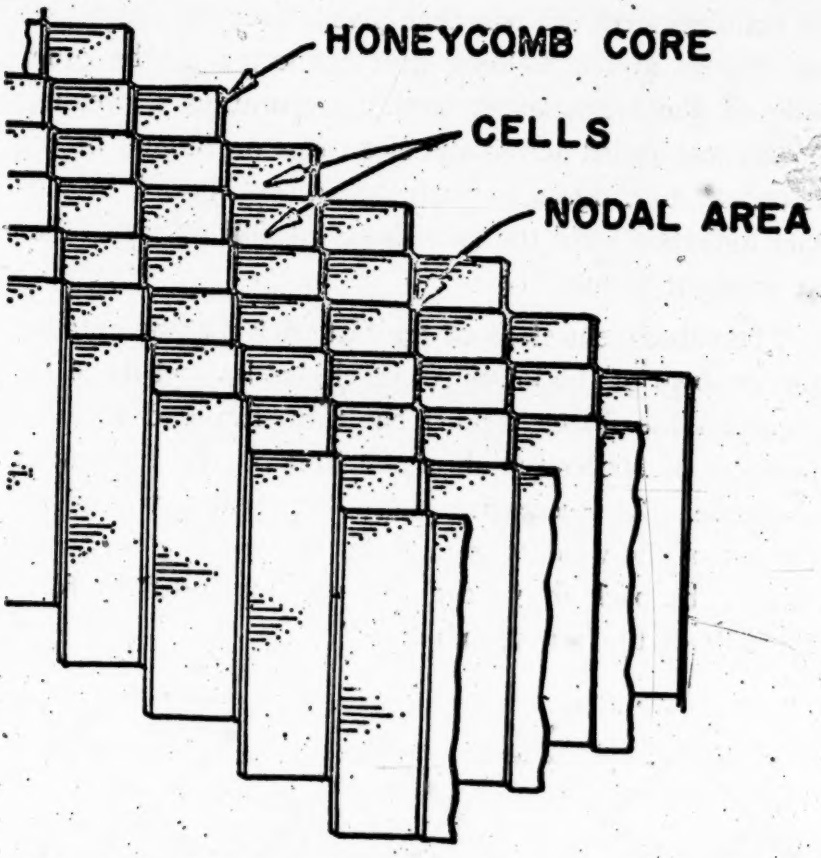
All of the questions in this appeal revolve around two methods of producing honeycomb core—the flat-pack method and the pre-formed or pre-expanded method.

---

[1]The word "plaintiff" will be used to designate plaintiff and its predecessors.

[2]"A person shall be entitled to a patent unless . . . (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States. . . ." 35 U.S.C. 102.

Honeycomb core produced by either method looks like this:



The text of the application for the patent, filed July 6, 1954, was almost exclusively devoted to the flat-pack method and described a process which appellant's brief farily summarizes as follows:[3]

"A first set of flat electrodes or fingers is placed on the top of the table and a flat sheet of stainless steel foil is placed over the first set of fingers. The first set of fingers is connected to a welding transformer. The fingers resemble a comb, and a similar second set of flat fingers is placed over the first sheet of foil with

[3]pp. 13-14 of Appellant's Brief.

the fingers of the second set located in between the fingers of the first set of fingers. A second flat sheet of stainless steel foil was then placed over the second set of fingers and a welding gun connected at the other side of the transformer and incorporating a welding roller, was rolled across the electrodes or fingers of the lower set of fingers to push the second sheet into contact and then weld the two sheets of foil to each other at adjacent points.

The subsequent steps of the flat-pack method entailed the removal of the lower set of electrodes and its placement on the upper welded sheet of foil and the disposition of successive sheets of foil on the uppermost electrode. The successive sheets were then welded by the use of the welding gun. After the welding was completed, the pack of welded foil was expanded to form the cells of the honeycomb core."

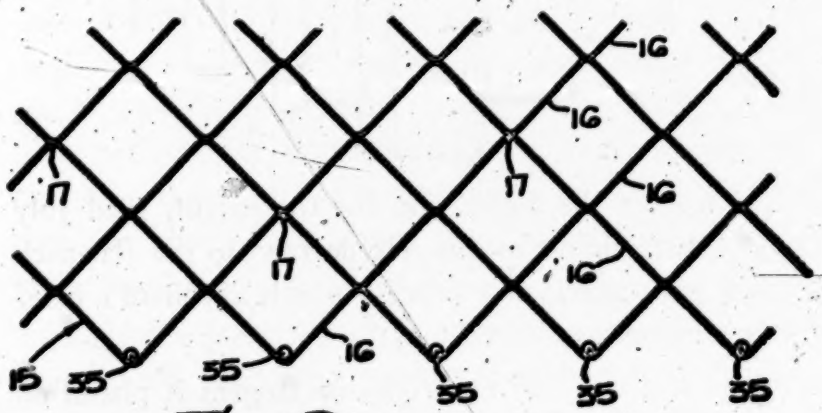


FIG. 6.

Except that Figure 6 (Figure 6 of the patent application) shown above depicts the core produced by either method (the pins 35 would not be shown in a drawing relating to the preform method), the drawings

in the patent relate solely to the flat-pack method and illustrate it as follows:

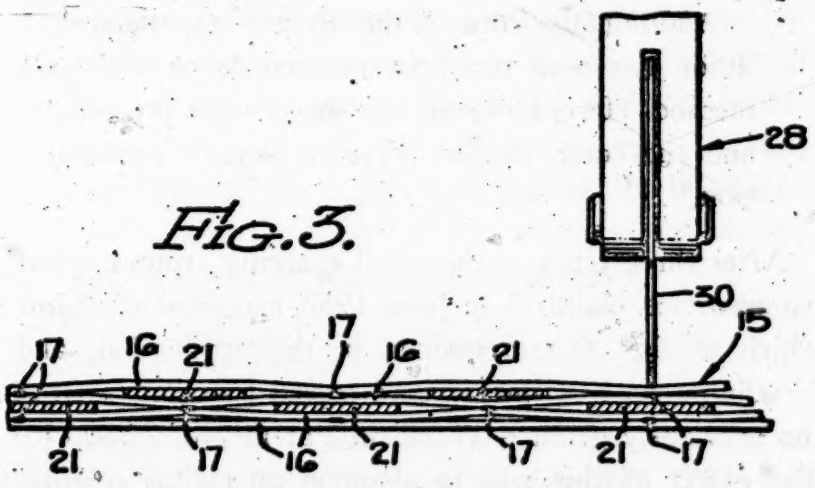


FIG. 3.

Figure 3 (Figure 3 of the patent application) shows the flat foil (No. 16), the fingers (No. 21), the welding gun (No. 28) and the seam welds (No. 17). The drawings here copied do not show it, but the fingers are inter-connected to form what is referred to as a comb. It is clear from the text and the drawings that the structure must be expanded after the welding. This is explained in the patent application:

> The final step is to expand the shaped structure. As indicated in Figure 6, this is accomplished by engaging the lowermost sheet (16) with stationary pegs or pins (35) and exerting a uniform pull on the uppermost sheet (16) to produce the structure shown. The expanded core is then utilized in the usual manner, usually being provided with skin elements (not shown), to form the desired sandwich structure.[4]

---

[4]P. 3, lines 11-18 of the letters patent No. 2,975,263.

The only reference in the original application to the preformed method was this:

> Additionally, core in the already expanded condition has been produced in accordance with said method. Here, however, the sheets were pre-formed and the comb fingers were of square configuration.[5]

After three years of the usual sparring around in the patent office, plaintiff, in June, 1957, cancelled all claims which at that time remained in the application, and for the purpose of interference copied two claims from the previously granted Wasilisin Patent No. 2,780,716. The effect of this was to abandon all claims relating to the flat-pack method and to rely entirely upon a method using pre-formed foil.

Claim No. 1 of the plaintiff's patent as finally allowed discloses this method and is as follows:

> The method of making seam-welded honeycomb core comprising the steps of placing a section of corrugated metal foil on a set of spaced, substantially disposed fingers of electrically conductive material, so that the lower portions of the corrugations extend down between the fingers while the upper portions of the corrugations rest upon the fingers, placing a second set of fingers in the lower portions of said section, placing a second section of corrugated metal foil on said second set of fingers so that the lower portions of said second section are in alignment with and contacting the upper portions of the first-mentioned section, placing an electrode in at least one lower portion of said

[5]P. 3, lines 26-30 of the letters patent No. 2,975,263.

second section of foil at a location directly above at least one of the fingers of the first-mentioned set, moving said electrode along said lower portion substantially in alignment with the longitudinal axis of the respective finger of said first-mentioned set while passing electric current between said electrode and said finger through both sections of foil whereby to seam-weld abutting portions of said first and second sections together.

The claims copied from Wasilisin were held to be prior to Wasilisin by the Board of Patent Interference.

That there are differences in the two methods of producing honeycomb core is irrefragable. The one method uses flat foil, employs relatively flat fingers, requires pressure from the welding wheel to bend an upper foil to meet a lower one, and requires a mechanical step of expansion. The other method uses pre-corrugated foil, square fingers, requires no pressure to bring the area to be welded together, and eliminates the expansion step. The pre-formed method lends itself more readily to automation and produces a more uniform core.

The District Court concluded that the Green patent 2,975,263 was invalid because directed to a subject matter in public use more than one year prior to the filing of the application. The conclusion was based on these findings:

XI.

The "said method" using flat material and known as the "flat-pack method" was in public use in 1952 and early 1953, more than one year prior to the filing of Green '263 on July 6, 1954.

XII.

The Foster [plaintiff's predecessor] sales of core made by "said method" were without limitation as to secrecy, or otherwise, and without any obligation on the part of the buyer to report to Foster upon what had been done with the core purchased.

XIII.

There was no change of experimentation in "said method" in the making of core using flat material after 1952, and the core made and sold was by a method in a perfected state.

There is sufficient evidence to support Findings Nos. XII and XIII and Finding No. XI to the extent that that finding relates to the flat-pack method. There were no sales of core produced by the pre-formed method made more than one year prior to the filing date of July 6, 1954.

The record fairly shows that during the period of 1952, 1953 and 1954 the use of welded stainless steel honeycomb core was relatively new. Major aircraft producers were testing it and experimenting with machines to produce it. During this period standards were being developed for the core. Plaintiff using the flat-pack method prior to June, 1953 produced and filled at least four separate orders for core. The money value of the core definitely shown to have been sold was not great, somewhere between five and six hundred dollars. Some core produced by the flat-pack method was given away. It is probable that most, if not all, of the core sold and given away was used by the purchasers for test and

experimental purposes, but certainly plaintiff put no limitation on the use to be made of it. The sales of core were sufficient to put the flat-pack method into public use and we cannot say on the record that the District Court erred in not finding the use experimental.

Having in mind the differences in material used, the steps of production, the adaptability to automation, and the finished product, did the sales of the core produced by the flat-pack method put the pre-formed method in public use? The guide lines, so far established are these: One sale or gift of an article is sufficient to constitute a sale or public use.[6] Where an article is sold the use is public even though the invention be hidden physically or chemically as a part of a larger article.[7] Likewise where an article is sold, there is a sale or public use of the article itself and of all improvements on the thing which would be obvious to one skilled in the art.[8] The holding in Stauffer v. Slenderella Systems of California, 254 F. 2d 127 (9th Cir. 1957), relied upon by appellant is not contrary. See footnote 2, page 128, and the next to the last paragraph at page 130. The language in the opinion appearing to be to the contrary is dictum, and not necessary to the holding of the case.

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[6]Smith & Griggs Mfg. Co. v. Sprague, 123 U. S. 249 (1887).

[7]Egbert v. Lippman, 104 U. S. 333 (1881); Hall v. Macneale, 107 U. S. 90 (1882); Metallizing Engineering Co. v. Kenyon Bearing and A. P. Co., 2 Cir. 1946, 153 F. 2d 516, cert. denied, 328 U. S. 840 (1946).

[8]International Tooth Crown Company v. Gaylord, 140 U. S. 55 (1891). See Dix-Seal Corporation v. New Haven Trap Rock Co. D. Conn. 1964, 236 Fed. Supp. 914, for an able discussion of the problem.

Where a process patent is involved and there is a sale of a product of the process, such is a public use of the process if the product sold discloses the process,[9] or even if it does not.[10]

None of these rules quite compel a result here—here there was no sale within the meaning of §102(b) of the pre-formed core as such, nor was there under any view of the evidence a public use of the exact method patented because, as indicated, the flat-pack method was abandoned in the patent office and the patent issued on claims describing the pre-formed method.

On the facts, the case which most nearly resembles this one is Smith & Griggs Mfg. Co. v. Sprague, 123 U.S. 249 (1887) where the court determined that the sale of a product made by a machine not identical with the one patented constituted a public use. There the patent covered a machine for making levers for boot buckles. The basic machine was used by the inventor in his own established business, and during a period of three years between 1874 and 1877 he made some 7,000,000 buckle levers with it. There was no real effort to keep the use of the machine secret. Within a year prior to the application for a patent the inventor made changes of which the court said:

> The alterations made in the machine in question, however useful, were not vital to its organization. Without them, it could and did work so as to be commercially successful.[11]

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[9]Soffron v. S.W. Lovell & Company, Cir. 1, 1957, 246 F. 2d 769.

[10]Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co., *supra*, note 7; Conmar Products Corp. v. Universal Slide Fastener Co., 2 Cir. 1949, 172 F. 2d 150; U. S. Chemical Corporation v. Plastic Glass Corp., 3 Cir. 1957, 243 F. 2d 892, cert. denied, 355 U. S. 836.

[11]Smith & Griggs Mfg. Co. v. Sprague, *supra*, 123 U. S. at p. 265.

The court finally concluded that the use was not experimental and that the patentee had therefore unduly delayed filing his patent application. We deduce from this case that not every improvement is sufficient to take a prior invention out of the operation of Section 102(b). The question then is—what degree of improvement is necessary?

If the purpose of 102(b) is to prevent an inventor from combining a period of monopoly resulting from a public exploitation of a secret use with the period of monopoly protection afforded by the patent,[12] then we see no reason for devising a different test for a process used than for an article sold or a publication made. In either case the invention should fall within 102(b) if the differences between the claimed thing and the sold or used thing are obvious to one skilled in the art. In either case unless the improvements would be patentable, the inventor has used or disclosed his invention contrary to the purpose of Section 102(b).

We agree with the district court that the process was in public use. Whether one method or two be involved and whether we treat the question as one of fact or law, the differences between the flat-pack method and the pre-formed method did not amount to an invention.

Once the flat-pack method is disclosed, we think that the appearance of the completed core in itself suggests to one skilled in the art the use of pre-corrugated foil.[13] After such suggestion the shape of the fingers

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[12]Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co., *supra*, note 7, 153 F.2d at p. 520.

[13]The prior art suggests the use of pre-corrugated metal. Smith (2,324,435) and Partiot (2,445,801) patents.

is dictated by the shape of the corrugation. The requirements for pressure on the welding wheel and an expansion step simply disappear.[14]

Hence we hold that the sales of core made by the flat-pack method constituted a public use of the pre-formed method and that under Section 102(b) the Green '263 patent is invalid. The judgment is affirmed.

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[14]At one stage plaintiff seems to have been in agreement. In plaintiff's closing brief in the interference proceeding, it was urged:

> Therefore it is readily apparent that Green et al, [plaintiff's predecessor], the senior party, rely on the entire disclosure of the application including the specification and the drawings [the drawings except for Figure 6 related to the flat-pack method] to support their right to make the two counts of the interference [both referring to the pre-form method] and *it is readily apparent to one skilled in the art how the teachings of the method would be applied to the manufacture of pre-formed core utilizing sections of corrugated metal foil.* (Emphasis added)

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"The Ninth Circuit Court of Appeals Has Decided an Important Question of Federal Law Which Has Not Been, but Should Be, Settled by This Court, Namely, Whether the Conditions of Patentability in 35 U.S.C. Section 103 May Be Applied Not as of the Date the Invention Was Made, but More Than One Year Prior to the Patent Application, to Invalidate the Invention Under 35 U.S.C. Section 102(b)" 17

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IN THE

Supreme Court of the United States

October Term, 1967

No. .....

TOOL RESEARCH AND ENGINEERING CORPORATION,
Petitioner,

vs.

HONCOR CORPORATION,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit, Brief for Honcor Corporation, Respondent in Opposition.

Opinion Below.

The District Court Opinion is reported at 240 F. Supp. 296, 145 USPQ 249, and the Judgment, Findings of Fact, and Conclusions of Law therein are set forth as Appendix A of the Petition in this matter.

The Court of Appeals decision is reported at 367 F.2d 449, 151 USPQ 236, and is set forth as Appendix B to the Petition.

Jurisdiction.

The jurisdictional requisites are adequately set forth in the Petition.

Question Presented.

Respondent disagrees with Petitioner's representations as to the questions presented and respectfully submits the real question to be as follows:

> Should 35 U.S.C. 102(b) be interpreted as to require the granting of a patent upon an invention which was obvious in the light of a related invention placed in public use more than one year prior to the filing of the application for patent?

Constitutional Provision and Statutes Involved.

The Constitution of the United States, Article I, Section 8:

> "The Congress shall have Power . . .
> * * *
> "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;"

35 U.S.C. 102:

> "A person shall be entitled to a patent unless—
> * * *
> "(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States, . . ."

35 U.S.C. 103:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences

between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Statement.

Petitioner, hereinafter called Tool Research, brought action in the District Court against respondent, hereinafter called Honcor, for infringement of United States Letters Patent 2,951,145, to Anspach and 2,975,263 to Green *et al.*

Anspach '145 was held by the District Court to be invalid and appellant abandoned the contest with respect thereto.

Green '263, filed in United States Patent Office on July 6, 1954, is directed to an alleged invention entitled "Method for Producing Honeycomb Structures". It was also held invalid by the District Court and that decision was affirmed by the Court of Appeals.

Tool Research's predecessor and assignor, the John F. Foster Company, made, gave away, and sold core made by "said method" disclosed in Green '263 using flat material more than one year prior to the Green '263 filing date.

The Green '263 patent teaches that "said method" is usable with flat material and with corrugated material (Green '263, Col. 3, lines 26-30).

The District Court held:

(a) "any difference between the use of 'said method' with flat material and with precorrugated material being such as to be obvious to one skilled in the art."

(F of F, IX; Pet. Appen. A, p. 4.)

(b) "The 'said method' using flat material and known as the 'flat pack method' (EAC) was in public use in 1952 and early 1953, more than one year prior to the filing of Green '263 on July 6, 1954."

(F of F, XI; Pet. Appen A, p. 5.)

(c) "The claims of the Green-Hagan '263 patent call for a method using precorrugated material which is 'unpatentable over' the same method using flat material which was in public use more than one year prior to the filing date of the Green '263 patent."

(C of L, 4; Pet. Appen. A, p. 12.)

The Court of Appeals agreed with the District Court and said:

(a) ". . . the invention should fall within 102(b) if the differences between the claimed thing and the sold or used thing are obvious to one skilled in the art. In either case unless the improvements would be patentable, the inventor has used or disclosed his invention contrary to the purpose of Section 102(b).

(Pet. Appen. B, p. 23.)

(b) "We agree with the District Court that the process was in public use. Whether one method or two be involved and whether we treat the question as one of fact or law, the differences between the flat pack method and the preformed method did not amount to an invention.

(Pet. Appen. B, p. 23.)

(c) "Once the flat-pack method is disclosed, we think that the appearance of the completed core in itself suggests to one skilled in the art the use of precorrugated foil. After such suggestion the shape of the fingers is dictated by the shape of the corrugation. The requirements for pressure on the welding wheel and an expansion step simply disappear."

(Pet. Appen. B. p. 23.)

As stated by the Court of Appeals petitioner at one time agreed that it was obvious to use the "flat pack" method with preformed core and its closing brief in an interference in the Patent Office contained the following:

"Therefore it is readily apparent that Green et al, (plaintiff's predecessor), the senior party, rely on the entire disclosure of the application including the specification and the drawings (the drawings except for Figure 6 related to the flat-pack method) to support their right to make the two counts of the interference (both referring to the preform method) and *it is readily apparent to one*

skilled in the art how the teachings of the method would be applied to the manufacture of pre-formed core utilizing sections of corrugated metal foil." (Emphasis added.)

(Pet. Appen. B, p. 24.)

It is seen that the District Court, the Court of Appeals, and the petitioner at an earlier time, agreed that the method using preformed material was obvious from the method using flat material. The latter was found to have been in public use more than one year prior to the filing of the application resulting in the Green patent in suit.

Petitioner contends that notwithstanding the foregoing it is entitled to a patent upon the obvious variant, really the "said method" according to the patent, and that the refusal of the Court of Appeals to recognize that fact involves important issues entitled to the consideration of this Court.

ARGUMENT.

I.

The Decisions of the Trial Court and of the Court of Appeals Are Clearly Correct.

35 U.S.C. Section 102(b) provides:

> "A person shall be entitled to a patent unless—
>
> * * * * *
>
> "(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States . . ."

It is petitioner's position that the public use of the method using flat material did not bar its right to a patent upon a method obvious in view thereof.

Stated differently, petitioner contends that 35 U.S.C. 102(b) has no application unless the method in public use was identical to the method claimed.

It is to be remembered that, as held by this Court in *Electric Storage Battery Co. v. Shimadzu,* 307 U.S. 5, 20, 83 L. Ed. 1071, 1081, 41 USPQ 155, 161 (1939):

> "The ordinary use of a machine or the practice of a process in a factory in the usual course of producing articles for commercial purposes is a public use."

In the *John Deere* Cases, *Graham v. John Deere, Calmar, Inc. v. Cook Chemical Co.* and *Colgate-Palm-*

olive Co. v. Cook Chemical Co., 383 U.S. 1, 148 USPQ 459 (Feb. 1966) this Court clearly stated:

> "At the outset it must be remembered that the federal patent power stems from a specific constitutional provision which authorizes the Congress 'To promote the Progress of . . . useful Arts . . .' This is the *standard* expressed in the Constitution and it may not be ignored. And it is in this light that patent 'validity requires reference to a standard written into the constitution.' "

The constitutional standard may be implemented by statutory direction and administered according to the statutory scheme but in a manner whereby to give effect to the constitutional standard. Petitioner seeks to have the statutory enactment interpreted in a manner which does not have that effect.

Petitioner, in effect, insists that the Constitutional standard be ignored, that a method obvious in the light of a method in public use be held patentable, and that a patent otherwise invalid for failing to measure up to that constitutional standard be held valid upon the grounds that it is patentable under the wording of 35 U.S.C. 102(b).

Petitioner's position is premised unrealistically upon semantics and not upon the fundamentals of the relevant law.

II.

The Present Case Does Not Present a Question of Public Importance in a Meaningful Context.

This Court has said:

> "While this Court decides questions of public importance it decides them in the context of meaningful litigation. . . ."
>
> *The Monrosa v. Carbon Black, Inc.*, 359 U.S. 180, 184.

It is difficult to recognize that the present litigation is meaningful in view of the following:

1. The Green '263 patent at column 3, lines 26-30 defines the method which petitioner seeks to patent as "said method" which the District Court found in public use more than one year prior to the Green application filing date;
2. The petitioner in the Patent Office admitted the method it now seeks to patent was obvious in the light of the method with other material (Pet. Appen. B, p. 24);
3. The District Court found the method petitioner here seeks to patent was obvious in view of the prior art (F of F, IX, Pet. Append. A, p. 4);
4. The Court of Appeals agreed with the District Court (Pet. Appen. B, p. 23);
5. If the method petitioner here seeks to patent was obvious in the light of the method in public use more than one year then it does not meet the Constitutional standard of invention; and
6. This Court has recently reaffirmed in the John Deere cases that an invention not meeting the Constitutional standard is not patentable.

III.

Relative to Petitioner's Reason I for Granting the Writ.

"The Ninth Circuit Court of Appeals Decided a Federal Question in a Way in Conflict With an Applicable Decision in This Court."

The "federal question" petitioner refers to is set forth *supra* under the title "QUESTIONS PRESENTED" on page .....

The statute was enacted in 1952. The "applicable decision" referred to by petitioner is *Smith & Griggs Mfg. Co. v. Sprague,* 123 U.S. 249 decided in 1887, some 60 years prior to the statute involved.

In construing Section 102 of 35 U.S.C. the Court of Appeals made a deduction from the early 1887 case of *Smith & Griggs v. Sprague* saying:

> "We deduce from this case that not every improvement is sufficient to take a prior invention out of the operation of Section 102(b)."
>
> (Pet. Appen. B, p. 23.)

Obviously, Smith & Griggs did not construe Section 102(b). Instead the Court of Appeals construed Section 102(b) using Smith & Griggs only as background.

Smith & Griggs did not pass upon the question of whether a variant "obvious" in view of an invention in public use could be patented by virtue of not being identical to that invention. Smith & Griggs clearly ruled that a non-experimental use in production for public sale was a public bar if continued for the statu-

tory period. During that period experiments were conducted and the machine changed. In the words of the judge of the circuit court, not this Court:

> "These changes, which are apparently not of great importance, perfected the invention, and enabled the inventor to take the final step between partial and complete success."

Whether in using the words "not of great importance" the circuit court judge meant they were "changes" in relatively unimportant parts of the machine, or whether he meant the extent of changes or modification in the prior structure were "relatively unimportant", is not clear. One thing is clear, however, and that is the question of whether the "changes" were or were not "obvious" was never considered, either by the circuit judge or by this Court. It follows that the Court of Appeals below in ruling:

> "In either case the invention should fall within 102(b) if the differences between the claimed thing and the sold or used thing are obvious to one skilled in the art."

was not deciding that question in conflict with any law laid down in Smith & Griggs.

In 1 Walker, Patents 355-56 (Deller's Edition 1937) it is stated:

> "Precise identity between the thing covered by the patent, and the thing which the inventor allowed to be in public use or on sale more than two years before he applied for that patent, is not necessary to constitute constructive abandonment

> of the invention covered by the latter. It is enough if the two devices are substantially the same (Hall v. Macneale, 107 U.S. 90 (1883); Theberath v. Trimming Co., 15 Fed. 246, 251 (1883)), or if the advance from one to the other did not amount to invention (International Tooth Crown Co. v. Gaylord, 140 U.S. 55, 62 (1891)), but it is not enough that the two devices perform the same function, and are somewhat similar in construction and in mode of operation. (Draper v. Wattles, 3 Bann. & Ard. 618, Fed.Cas. No. 4,073 (1878))."

In the decision of this Court in *Hall v. Macneale,* 107 U.S. 90, 2 S.Ct. 73, 27 L.Ed. 367, this Court said at page 97 in holding that a nonexact earlier use destroyed patentability:

> "The invention was complete in those safes. It was capable of producing the results sought to be accomplished though not as thoroughly as with the use of welded steel and iron plate."

The courts have long followed the rule that the earlier use need not be of the exact thing patented in order to prevent a variant being patentable. In *National Biscuit Co. v. Crown Baking Co.,* 105 F.2d 422, 42 USPQ 214 (1st Cir. 1939), the Court said:

> "Undoubtedly the machines on the alleged prior use must be capable of being operated commercially, but it is not necessary to prove that such earlier machines were as efficatious as the one for which the patent was granted. Smith & Griggs Mfg. Co. v. Sprague, supra. If they embodied substantially the principles and elements of the invention, they invalidated the patent."

Similar holdings may be found in *Atlas v. Eastern Airlines, Inc.*, 311 F.2d 156, 162; 136 USPQ 4, 8-9 (1st Cir. 1962), cert. denied, 373 U.S. 904, 83 S.Ct. 1290, 10 L.Ed. 2d 199, 137 USPQ 912 (1963); *Sperry Rand Corp. v. Bell Tel. Labs., Inc.*, 208 F.Supp. 598, 135 USPQ 254 (S.D. N.Y. 1962), appeal dismissed, 317 F.2d 491, 137 USPQ 497 (1963); *Morrill v. Automatic Indus., Inc.*, 93 F.Supp. 697, 87 USPQ 70 (W.D. Mo. 1950). Also see *Trimpak Corp. v. Schenectady Lumber Co.*, 29 F.Supp. 85, 89, 42 USPQ 363, 367 (N.D. N.Y. 1939) aff'd mem., 119 F.2d 424, 49 USPQ 756 (1941), where the court cited Walker on Patents with approval.

IV.

Relative to Petitioner's Reason II for Granting Writ.

"35 U.S.C. Section 103, Enacted in 1952 Overruled Smith & Griggs as Interpreted by the Ninth Circuit Court of Appeals."

Analyzing the above "Reason" for better understanding we need to focus upon (1) Smith & Griggs as interpreted by the Ninth Circuit Court of Appeals; and (2) 35 U.S.C. Section 103.

As to (1), the Court of Appeals below said relative to Smith & Griggs:

> "We deduce from this case that not every improvement is sufficient to take a prior invention out of the operation of Section 102(b)."

As to (2), Section 103 provides:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the dif-

> ferences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. . . ."

As viewed by the Court of Appeals "not every improvement" escaped the bar to a patent raised by Section 102(b).

As recited in Section 103 if the particular improvement or difference were "obvious" it is not patentable.

There is no inconsistency and clearly Section 103 is in complete agreement with the deduction of the Court of Appeals drawn from Smith & Griggs.

We find petitioner here in the interesting position of contending that the Court of Appeals incorrectly interpreted Smith & Griggs and then supplementing that contention by the further contention that 35 U.S.C. 103 overruled that incorrect interpretation.

As stated by this Court in the *John Deere* cases, 35 U.S.C. Section 103 did not change the standard for patentability. This Court there said:

> "Although we conclude here that the inquiry which the Patent Office and the courts must make as to patentability must be beamed with greater intensity on the requirements of §103, it bears repeating that we find no change in the general strictness with which the overall test is to be applied. We have been urged to find in §103 a relaxed standard, supposedly a congressional reaction to the 'increased standard' applied by this Court in its decisions over the last 20 or 30 years. The standard has remained invariable in this Court. . . ."

Graham v. John Deere, 383 U.S. 1, 19 (1966).

Petitioner cites numerous lower court decisions to support its contention that Section 102(b) does not bar a patent unless the prior public use is of the identical invention claimed in the application for patent which is being denied. To the extent that any of those decisions support the view that 35 U.S.C. 102(b) must be so interpreted as to require the granting of a patent upon subject matter obvious in the light of prior art they cannot stand.

Petitioner cites nine cases, three of which are by Courts of Appeal and six of which are by District Courts. Of the cases cited, two District Court cases support petitioner's position. They are:

Chicopee Mfg. Corp. v. Columbus Fiber Mills Co., Inc. (D.C. M.D. Georgia, 1958), 165 F. Supp. 307, 118 USPQ 53, 65;

Kaiser v. McLouth Steel Corporation (DC ED, Mich., 1966), 257 F.Supp. 372, 150 USPQ 239.

Of the remaining cases, none seriously or carefully considered the present issue.

In *Adams et al. v. Columbus Mfg. Co., Inc.* (M.D. Georgia 1960), 180 F.Supp. 921, 124 USPQ 92, so far as Section 102(b) was concerned, turned on the fact that the alleged public use was in fact experimental and so was not a bar.

In *Felburn v. The New York Central Railroad Company* (6 Cir., 1965), 350 F.2d 416 USPQ 622, the claims of the patent were held invalid under Section 103 although novel under the test of Section 102(b) because not identically disclosed in the prior art, the

court being of the view that such novelty alone would not support validity.

In *Wolowitz v. Gulf Oil Corporation* (DC, 1966), 255 F.Supp. 100, 149 USPQ 737, 739, the court said, in passing, that if a single reference did not disclose the invention claimed in all material respects then Section 103 and not Section 102 is applied.

In *Technicon Instruments Corp. v. Coleman Instruments Inc.* (ND Ill., 1966), 255 F.Supp. 630, 150 USPQ 227, 233, the question of identity of prior art to the claimed invention as to justify the application of Section 102(b) was not considered.

In *George R. Churchill v. American Buff* (7 Cir., 1966), 365 F.2d 129, 150 USPQ 417, the court found that the product sold was the product claimed and the question of obviousness did not arise.

In *J. L. Clark Mfg. Co. v. American Can Co.* (DC NJ, 1966), 256 F.Supp. 719, 151 USPQ 313, what the court said about Section 102(b) was *obiter dictum:*

> ". . . While a determination of this issue is not essential, in view of our holding of invalidity for lack of invention . . ."

In *Ling-Temco-Vought, Inc. v. Kollsman Instrument Corp.* (2 Cir. 1967), ...F.2d ....., 152 USPQ 446, the remarks of the court relative to Section 102(b) were incidental for the prior art was admittedly in existence at the time the invention of the patent in suit was made and the case was decided under Section 103.

These cases give very slight support to petitioner's position.

V.

Relative to Petitioner's Reason III for Granting the Writ.

"The Ninth Circuit Court of Appeals Has Decided an Important Question of Federal Law Which Has Not Been, but Should Be, Settled by This Court, Namely, Whether the Conditions of Patentability in 35 U.S.C. Section 103 May Be Applied Not as of the Date the Invention Was Made, but More Than One Year Prior to the Patent Application, to Invalidate the Invention Under 35 U.S.C. Section 102(b)."

As petitioner states, the Court of Appeals did say that:

> ". . . the invention should fall within 102(b) if the differences between the claimed thing and the sold or used thing are obvious to one skilled in the art."

Section 102(b) provides that a patent cannot be obtained if

> "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application . . ."

Petitioner contends that the "invention" referred to must be the *identical* invention in order that Section 102(b) apply and that obvious variants are not included.

Section 103 refers to obvious variants but relates to obviousness as of the "time the invention was made" and not to obviousness "more than one year prior to the date of the application."

No Court has faced this situation more squarely than the Court of Customs and Patent Appeals in a series of cases now to be discussed.

In a first decision, *In re Palmquist*, 51 CCPA 839, 319 F.2d 547, 138 USPQ 234, decided in 1963, the Court of Customs and Patent Appeals held that for Section 102(b) to be applicable the alleged public use more than one year prior to filing must fully disclose in every detail the claimed invention. This eliminated the use of obvious variations and modifications to anticipate.

The effect of the *In re Palmquist* decision was a breach in the long established law that one cannot obtain a patent upon that which has been in public use for more than one year prior to filing, or upon an obvious variation thereof.

The Court of Customs and Patent Appeals in two later decisions reversed *In re Palmquist* and returned the law for the Patent Office to the place it had been. They were as follows:

In re Foster (CCPA, April 15, 1965), 343 F.2d 980, 145 USPQ 166;

In re Folkers (CCPA, May 13, 1965), 344 F.2d 967, 145 USPQ 426.

In *In re Foster* the Court said:

"'Manifestly, Section 102(b) from its earliest beginnings has been and was intended to be directed toward the encouragement of *diligence* in the filing of patent applications and the protection of the public from monopolies on subject matter which had already been fully disclosed to it.'

"These statements are in accord with our understanding of the history and purposes of section 102(b). It presents a sort of statute of limitations, formerly two years, now one year, within which an inventor, even though he has made a patentable invention, must act on penalty of loss of his right to patent. What starts the period running is clearly the availability of the invention *to the public* through the categories of disclosure enumerated in 102(b), which include 'a printed publication' anywhere describing the invention. There appears to be no dispute about the operation of this statute in 'complete anticipation' situations but *the contention seems to be that 102(b) has no applicability where the invention is not completely disclosed in a single patent or publication,* that is to say where the rejection involves the addition to the disclosure of the reference of the ordinary skill of the art or the disclosure of another reference which indicates what those of ordinary skill in the art are presumed to know, *and to have known for more than a year before the application was filed.* Upon a complete reexamination of this matter, we are convinced that the contention is contrary to the policy consideration which motivated the enactment by Congress of a statutory bar. On logic and principle we think this contention is unsound, and we also believe it is contrary to the patent law as it has actually existed since at least 1898.

* * * * *

". . . If the reference contains enough disclosure to make his invention obvious, the principle of

the statute would seem to require denial of a patent to him. The same is true where a combination of two publications or patents makes the invention obvious and they both have dates more than a year before the filing date." (343 F. 2d 980, 987-8, 145 USPQ 166, 173).

* * * * *

". . . But on further reflection, we now feel bound to point out that of equal importance is the question of *loss of right* predicated on a one-year *time-bar* which, it seems clear to us, has never been limited to 'anticipation' situations, involving only a single reference, but has included as well 'no invention' (now 'obviousness') situations. It follows that where the time-bar is involved, *the actual date of invention becomes irrelevant* and that it is not in accordance with either the letter or the principle of the law, or its past interpretation over a very long period, to permit an applicant to dispose of a reference having a date more than one year prior to his filing date by proving his actual date of invention.

"Such a result was permitted by our decision in Palmquist and to the extent that it permitted a reference, having a publication date more than one year prior to the United States filing date to which the applicant was entitled, to be disposed of by proof of a date of invention earlier than the date of the reference, that decision is hereby overruled." (343 F. 2d 980, 989, 145 USPQ 166, 174).

In *In re Folkers* the Court said:

"Whatever right to a patent appellant may have had at the time the invention was made, it has

> been lost within the meaning of section 102(b), *if*, indeed, the claimed invention *became* obvious to one of ordinary skill in this art through the publication of the reference more than one year before appellant filed his application." (344 F.2d 967-8, 145 USPQ 426, 427).

The soundness of the law as recognized by the Court of Customs and Patent Appeals is clear and is consistent with the Constitutional purpose.

Petitioner contends it is entitled to a patent upon an obvious variant of a process in public use for more than one year, the statutory period, if it can establish that it made the obvious variant prior to the running of the one year bar.

Petitioner would eat its cake and still have it. Let us assume Petitioner invents two modifications, not patentably distinct, one being an obvious variant of the other, and uses one publicly for years. It then applies for a patent upon the second variant and successfully overcomes the bar of public use provided by Section 102(b) by showing that at the time the invention comprising the second variant was made there was no public use making it obvious. Petitioner would then receive a patent upon its second modification which does not meet the Constitutional standard for it does not "promote the progress of the useful arts" being an obvious variant of something already in the public domain.

Notwithstanding this clear frustration of the Constitutional purpose by giving to Section 102(b) the interpretation for which it contends, petitioner insists the words of the section so require.

Conclusions.

The statutes must be interpreted as to give effect to the Constitutional intent to promote the useful arts in the granting of a patent.

An interpretation of 35 U.S.C. 102(b) which requires that a patent be issued upon an invention which has been obvious for more than a year in the light of prior public knowledge or use does not carry out the Constitutional intent.

The position of petitioner is based upon semantics, not upon the basic law, and is without merit.

Respectfully submitted,

WM. DOUGLAS SELLERS,
RICHARD D. SELLERS,
By W. D. SELLERS,
Attorneys for Respondent.

Of Counsel:
SELLERS & BRACE.

IN THE

Supreme Court of the United States

October Term, 1967
No. 1228

TOOL RESEARCH AND ENGINEERING CORPORATION,

Petitioner,

vs.

HONCOR CORPORATION,

Respondent.

Motion for Leave to File Petition for Rehearing of Order Denying Petition for Writ of Certiorari Out of Time.

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Petitioner, Tool Research and Engineering Corporation, hereby respectfully moves this Court for an Order permitting it to file its Petition for Rehearing of the Order Denying its Petition for Writ of Certiorari, Out of Time.

This Motion is based on each and all of the following grounds:

1. On May 22, 1967, this Court made its Order Denying the Petition for Writ of Certiorari in the within cause.

2. Sidney Dorfman, Esq., Petitioner's general counsel, was hospitalized from the end of March, 1967, until June 3, 1967, with a critical gastric condition.

3. On June 3, 1967, Mr. Dorfman was released from the hospital under twenty-four hour medical and nursing supervision and was rehospitalized on June 30, 1967, because of deterioration in his condition.

4. Mr. Dorfman passed away on July 11, 1967.

5. As a result of Mr. Dorfman's serious illness, the undersigned, Lawrence H. Nagler, Esq., a member of the California Bar, but not of the United States Supreme Court Bar, assisted Mr. Dorfman in the preparation of the Petition for Writ of Certiorari, as well as the Petition for Rehearing of the Order Denying said Petition.

6. The Petition for Rehearing of the Order Denying the Petition for Writ of Certiorari was completed and delivered to Petitioners printer, Parker & Son, Inc., 241 East 4th Street, Los Angeles, California 90013, on June 14, 1967.

7. The last day for filing the Petition for Rehearing was Friday, June 16, 1967, and the undersigned was assured by said printer that the document would be received by the United States Supreme Court on the morning of June 16, 1967, within the time permitted under Rule 58 of the Rules of the Supreme Court of the United States.

8. The Petition for Rehearing was printed and mailed to the United States Supreme Court on June 15, 1967, but Mr. Richard Shean, the Director of Printing of Parker & Son, Inc., mistakenly sent said Petition for Rehearing by Air Express, rather

than by Emery Air Freight, whereas if the document had been sent by the latter method, it would have reached this Court within the time alloted under Rule 58, and as promised to Petitioner. See the attached Declaration by Richard Shean, marked Exhibit "A" and incorporated by reference herein, as though fully set forth.

9. The Petition for Rehearing contains clarification of matters of substantial national importance regarding the absence of definitive guidelines in the area of Patent Law applicable to the within case, with the resultant derogation of the Constitutional intent of promoting the useful arts in the granting of a patent.

As a result of the above-noted difficulties in the preparation of the Petition for Rehearing and the mistake of Petitioner's printer, forty (40) copies of the Petition for Rehearing were received by the Clerk of this Court on Monday, June 19, 1967, one business day after the time provided in Rule 58 for the filing of such Petitions.

Wherefore, Petitioner prays for an Order granting its Motion for Leave to File its Petition for Rehearing of Order Denying Petition for Writ of Certiorari, Out of Time.

LAWRENCE H. NAGLER,
Attorney for Petitioner.

Order.

The Motion having been read and considered, and good cause appearing therefrom, it is hereby Ordered that Petitioner be permitted to file its Petition for Rehearing of Order Denying Petition for Writ of Certiorari, out of time.

.....

Justice of The Supreme Court
of The United States

EXHIBIT "A"

Declaration of Richard Shean.

State of California, County of Los Angeles—ss

I, Richard Shean, Declare as Follows:

1. I am the Director of Printing of Parker & Son, Inc., 241 East 4th Street, Los Angeles, California 90013.

2. On June 14, 1967, Lawrence H. Nagler, Esq., delivered to me Petitioner's Petition for Rehearing of Order Denying Petition for Writ of Certiorari, and informed me that said document had to be filed with the Clerk of the Supreme Court of the United States during business hours, no later than Friday, June 16, 1967. I assured Mr. Nagler that the document would be filed within the permitted time.

3. The document in question was printed and shipped by Air Express on June 15, 1967, when it should have been shipped by Emery Air Freight.

4. Had the document been mailed by the latter method, it would have arrived at the office of the Clerk of the Supreme Court of the United States during business hours on June 16, 1967, but due to the fact that I did not make a written notation on the records of Parker & Son, Inc., to the effect that this document was to be shipped by Emery Air Freight, it was not so shipped.

5. As a result of this mistake in the records of Parker & Son, Inc., the document did not arrive at the Office of the Clerk of the Supreme Court of the United States until Monday, June 19, 1967, one busi-

ness day after the time permitted under Rule 58 for the filing of such petitions.

I declare under the penalty of perjury that the foregoing is true and correct.

Executed on July 21, 1967 at Los Angeles County, California.

RICHARD SHEAN

Subscribed and sworn to before me this 21st day of July, 1967.

MARGARET FALES,
Notary Public in and for the County of Los Angeles, State of California.

My Commission Expires January 11, 1970.